

REMARKS

Claim 1 is amended to recite that the thickness of the double-sided pressure-sensitive adhesive tape is from 10 to 50 μm . Support is found for example, at page 32, line 8 of the specification as filed. No new matter is presented.

Entry of the Amendment after final rejection is proper to place the application in condition for allowance.

I. Response to Claim Rejections Under 35 U.S.C. § 112

1. Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. §112, first paragraph, because the specification, while being enabling for a double-sided PSA tape comprising at least two PSA layers, wherein both PSA layers are compositionally different from each other, allegedly does not reasonably provide enablement for both PSA layers having same composition.

The Examiner maintains that the difference in the adhesive strength as claimed can be achieved by (A) providing both PSA layers with same adhesive composition (i.e. each PSA layer is formed of same monomer and weight% of said monomer in each PSA layer is same). According to the Examiner, in this arrangement, since each adhesive layer is bonded to a different substrate (i.e. PSA 1 is bonded to norbornene and PSA 2 is bonded to glass or triacetal cellulose); the adhesive strength of each adhesive will be different or (B) both PSA layer have different adhesive strengths because each PSA is formed of a different composition (i.e. each PSA layer is formed of same monomer, except that weight% of said monomer in each layer is different).

It is the Examiner's position that Applicant's specification is only enabling for situation/embodiment described in (B), but the claims are broader in scope such that the

situation/embodiment described by (A) is also encompassed by the scope of claim 1. Therefore, the Examiner asserts that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope (i.e. situation/embodiment described by (A)) with these claims.

Applicants respectfully traverse the rejection.

Apparently, the Examiner considers an embodiment wherein each PSA layer is formed of the same monomer and weight % of the monomer in each PSA layer and wherein the adhesive strength of both PSA layers is different, i.e., due to bonding to different substrates, to be non-enabled by the specification.

The specification is enabled for both embodiments (A) and (B) set forth by the Examiner for the reasons of record which are incorporated herein by reference. Specifically, the claim language states “wherein at least one pressure-sensitive adhesive layer of the pressure sensitive adhesive layer of the pressure-sensitive adhesive layers of both outer sides has a 180°-peeling adhesive strength (to a glass plate or a triacetyl cellulose film at a peeling rate of 300 mm/min at 23°C) of not more than 5.0 N/20 mm”. That is, in the case of the outer adhesive layer to a glass plate and in the case of the outer adhesive layer to a triacetyl cellulose film, the peeling strength is the same, i.e., not more than 5.0 N/20 mm. This is described in the specification in the paragraph bridging pages 14-15.

Moreover, it is described in the specification that it is preferable that the 180°-peeling adhesive strength (to a norbornene based resin film at a peeling rate of 300 mm/min at 23°C) of the pressure-sensitive adhesive layer in the touch panel side is larger than the 180°-peeling adhesive strength (to a glass plate or a triacetyl cellulose film at a peeling rate of 300 mm/min at

23°C) of the pressure-sensitive adhesive layer in the display device side. Specifically, the 180°-peeling adhesive strength (to a norbornene based resin film at a peeling rate of 300 mm/min at 23°C) of the pressure-sensitive adhesive layer in the touch panel side is preferably 5.5 N/20 mm or more (for example, from 5.5 to 25 N/20 mm), and more preferably 6.0 N/20 mm or more (for example, from 6.0 to 20 N/20 mm). Thus, the peeling strength may be different.

Even further, the specification at page 20, line 22 to page 21 line 4 states, “the pressure-sensitive adhesive of forming the pressure-sensitive adhesive layer in the touch panel side, the pressure-sensitive adhesive of forming the pressure-sensitive adhesive layer in the display device side, and the pressure-sensitive adhesive of forming other pressure-sensitive adhesive layer (intermediate pressure-sensitive adhesive layer) may be the same kind of pressure-sensitive adhesive or different kinds of pressure-sensitive adhesives among them.”

The specification further teaches at the paragraph bridging pages 28-29 that “in the case where the pressure-sensitive adhesive layer in the touch panel side and the pressure-sensitive adhesive layer in the display device side are each formed of an acrylic pressure-sensitive adhesive, by employing a method such as a method of lowering the proportion of the modifying monomer (functional group-containing copolymerizable monomer) as far as possible, a method of making the crosslinking structure minute using a relatively large amount of the crosslinking agent, and a method of using a surfactant, it is possible to make the adhesive strength of the pressure-sensitive adhesive layer in the display device side to the display surface of the display device lower than the adhesive strength of the pressure-sensitive adhesive layer in the touch panel side to the sticking surface of the touch panel.”

The specification further teaches “it is preferable that the adhesive strength of each of the pressure-sensitive adhesive layer in the display device side and the pressure-sensitive adhesive layer in the touch panel side is controlled by lowering the proportion of the functional group-containing copolymerizable monomer as far as possible. In that case, it is desirable that the proportion of the functional group-containing copolymerizable monomer is in the range of not more than 5 % by weight (preferably not more than 3 % by weight) based on the whole amount of the monomer components.”

Thus, in order to achieve either embodiment, the specification provides sufficient guidance and it is within the knowledge and skill of the skilled artisan to adjust the composition of the outer adhesive layers, whether the monomer and weight % of the monomer in each PSA layer is the same or different, without undue experimentation, to achieve the desired result, both of which are within the scope of the invention and enabled by the specification.

Accordingly, Applicants respectfully request withdrawal of the rejection.

2. Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement regarding the recitation that “the double-sided pressure-sensitive adhesive has a thickness of not more than 50 μm ”.

Without conceding the merits of the rejection and merely for the purpose of advancing prosecution, claim 1 is amended herein to recite that the double-sided pressure-sensitive adhesive has a thickness of 10 to 50 μm as supported by the specification at page 32, line 8.

Accordingly, Applicants respectfully request withdrawal of the rejection.

III. Response to Claim Rejections Under 35 U.S.C. § 103

1. Claims 1, 2, and 5 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kishioka (US 2002/0098352 A1) in view of Hitoshi et al. (EP 0930322A2) for the reasons of record.

2. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kishioka (US 2002/0098352 A1) in view of Hitoshi et al. (EP 0 930 322 A2) as applied to claims 1, 2, and 5 above, and further in view of Okabe et al. (JP 07- 105781-abstract and English translation) for the record.

Applicants respectfully traverse the rejections for the reasons of record, which are incorporated herein by reference.

Specifically, the combination of Kishioka et al and EP '322 would not *necessarily* result in the claimed total thickness of the PSA sheet, the same monomer as the major component in each of the PSA layers and/or the amount of the major monomer component. Consequently, the combination of Kishioka et al and EP '322 would not *necessarily* result in a double-sided PSA tape having the claimed peeling adhesive strengths. Additionally, that the Examiner is not properly considering the claimed invention as a whole, but is instead improperly considering obviousness of individual elements of the claims. Moreover, Okabe et al does not remedy the deficiencies of Kishioka et al and EP '32 for the reasons of record and therefore, even if combined with Kishioka and EP '322, the present invention would not have been achieved.

Accordingly, Applicants respectfully request withdrawal of the obviousness rejections under 35 U.S.C. § 103.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

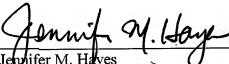
SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON DC SUGHRUE/265550

65565

CUSTOMER NUMBER

Date: September 16, 2010


Jennifer M. Hayes
Registration No. 40,641